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| 10/649,529 | 08/27/2003 | Jack C. White | TGXX.-1002USDIV3 | 5445 |
| 23859 | 7590 | 06/20/2005 | EXAMINER | |
| NEEDLE & ROSENBERG, P.C. | | | BEHREND, HARVEY E | |
| SUITE 1000 | | | ART UNIT | |
| 999 PEACHTREE STREET | | | PAPER NUMBER | |
| ATLANTA, GA 30309-3915 | | | 3641 | |

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,529

Applicant(s)

WHITE ET AL.

Examiner

Harvey E. Behrend

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/23/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28, 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-28, 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24-28, 30-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The elected species is specie II, (the embodiment of Fig. 3).

The claimed second portion which contain the plurality of recesses, is tray 108 of said Fig. 3.

There is no support in the original disclosure for reciting that tray 108 is a radiation shielding material selected from either lead or steel or a combination thereof.

Note that lines 20-23 of page 9 of applicants specification states that tray 108 is instead, made of plastic and, the last two lines of said page 9 lists several examples of suitable plastic materials.

There is also no support in the original disclosure for referring to a combination of lead and steel.

There is no support in the original disclosure for reciting the film as being of lead or steel or a combination thereof.

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There is no support in the original disclosure for the subject matter of new claims 35-38.

Claims 35 and 36 depend directly from claim 24. Claim 24 does not recite the second portion as including a film.

Since it is the claimed "second portion" which defines the plurality of recesses, it is simply not possible on its face for this "second portion" which defines the recess, to also "substantially cover" the recesses in the second portion (as in claim 35) or, to "at least cover" the radioactive material contained in the device which is in the recesses in the second portion (as in claim 36).

The film (which is disclosed as covering the recesses), is disclosed only as covering all of the recesses and hence, all of the devices positioned in the recesses. There is thus, no support in the original disclosure for referring to the "second portion" or the "film", as only substantially covering the recesses as in claims 35 and 37 nor, for the "second portion" or the "film", as at least covering the radioactive material in the device as in claims 36 and 38.

Note that the term "at least" reads on covering only the radioactive material of one device and not any of the portions of the second device between the recesses nor, even, covering all of the devices (the original disclosure provides no support for such).

There is no support in the original disclosure for stating that one device, can actually be housed in a plurality of recesses (see for example, claims 36 and 38).

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There is no support in the original disclosure for reciting that the “second portion” or “film” is actually able to be positioned inside the device so as to be able to cover the radioactive material within the device, as recited in claims 36 and 38.

3. Claims 24-28, 30-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite and incomplete.

Line 2 of claim 24 positively recites the presence of only one device. There is hence no proper antecedent for referring to a plurality of “said devices” (e.g. see lines 3 and 9 of claim 24).

The claims are vague, indefinite and incomplete as to what all is meant by and is encompassed by, the term, a combination of lead and steel.

The claims are vague, indefinite and incomplete as to what all is meant by and is encompassed by, the terms “substantially covers” and “at least covers” and the metes and bounds of the claims are hence undefined.

Note also that terms such as “substantially” are relative and can be given no definite meaning.

Claim 33 has been amended to remove only part of the “such that” phrase, (note the reference to the “such that” phrase on page 3 of section 4 of the 10/21/04 Office action). Claim 33 as amended, retains the term “generally” (which was part of the “such that” phrase). The term “generally” however, is relative and can be given no definite

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meaning, and thus, claim 33 is still vague and indefinite as to exactly what is being claimed.

The claims are still vague, indefinite and incomplete, particularly as the claims improperly define one unknown (e.g. the size of the recesses) in terms of another unknown (e.g. the size, shape, etc. of a device containing radioactive material or indeed, any device or object such as a paper clip, pencil, a tube of lipstick, etc., since clearly, one could place in the recess, any object that would fit therein, including objects that are smaller than the recess). The metes and bounds of the claims are hence undefined.

Dispite applicants arguments to the contrary (page 5 of the 3/23/05 response), the amendments to claim 24 do not overcome this issue.

This is because amended claim 24 only positively recites the presence of one device, and, a plurality of recesses. There is no recitation for example, that all devices are identical and that all recesses are identical.

Thus, the other recesses (i.e. other than the one recess containing the positively recited one device) are still being improperly defined in terms of another unknown (e.g. the size) shape, etc. of a device containing radioactive material or indeed, any device or object such as a pencil, tube of lipstick, etc., since clearly, one could place in these other recesses, any object that would fit therein, including objects that are smaller than the recess.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 24-28, 32, 34-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mistry (U.S. 4759345) (cited by applicant).

Note particularly Figs. 2, 5, 10 and cols. 3, 5, 6.

The claimed “first portion” reads on either steel shielding container 44 or lead component 8.

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The claimed "second portion" reads on removable stainless steel component 45 which has recesses 9 therein. As shown for example in Fig. 2, these recesses are sized to accommodate or house, needles 36. The needles 36 contain radioactive seeds.

The term "magazine" reads on needles 36.

The needles 36 will be inherently be in contact with at least a portion of recesses 9. Any two surfaces in contact with one another will inherently provide a "friction fit" as recited in applicants claim 27.

Such also provides a "slip fit" as recited in applicants claim 28.

Claims such as claims 35, 36 read on the stainless steel in which the recesses 9 are formed.

Note that claim 36 does not require the "second portion" to completely cover the radioactive material.

7. Claims 24, 27, 28, 32, 34-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lammers (U.S. 3259748).

The claimed "first portion" reads on the refrigerated cabinet 10. Note that any material will inherently function as a shield for different forms of radiation, at least to a certain extent.

The claimed "second portion" reads on lead shielding blocks 44, 46, 48 having recesses or cavities 52 therein. These recesses 52 house containers C, containing radioactive isotopes.

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These containers will be resting against and in contact with, at least a portion of the inner surface of recesses 52.

Any two surfaces in contact with one another, inherently provide a "friction fit".

Such also inherently provides a "slip fit".

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

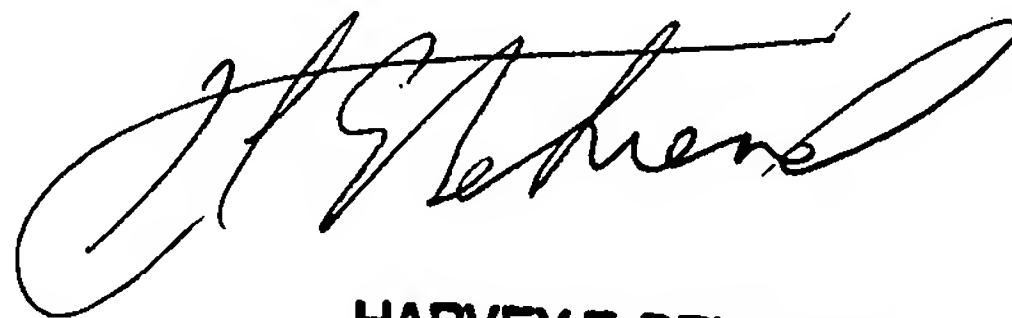
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication should be directed to Harvey E. Behrend at telephone number (571) 272-6871. The examiner can normally be reached Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieved (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "H. E. Behrend", with a large, stylized loop at the end.

**HARVEY E. BEHREND
PRIMARY EXAMINER**

Behrend/vs
June 9, 2005